

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3, 5, 7 and 9-17 are pending in the present application. Claims 1, 3, 7 and 9-11 are amended; Claims 2, 4, 6 and 8 are canceled without prejudice or disclaimer; and Claims 12-20 are added by the present amendment.

Claim amendments and new claims find support in the claims and specification as originally filed, at least at page 9, lines 1-23, page 13, lines 3-15, page 15, lines 3-24, and page 33, lines 11-25. Thus, no new matter is added.

In the outstanding Office Action, Claims 1-11 were rejected under 35 U.S.C. § 102(b) as anticipated by or under 35 U.S.C. § 103(a) as being obvious over Japanese Patent No. JP 06-052541 to Katsumi et al. (herein “Katsumi”). Applicants respectfully traverse that rejection with respect to amended Claim 1 and new Claim 12.

Amended Claim 1 is directed to a magnetic recording medium that includes a nonmagnetic layer and a magnetic layer. The magnetic layer includes a magnetic powder, a binder resin and an abrasive. Further, the magnetic layer is configured to store information to be reproduced by a magneto-resistive (MR) head. An average height of protrusion of the abrasive from a surface of the magnetic layer measured using an AFM is in the range of 7.0 to 15.0 nm, and a nonmagnetic substrate to which the nonmagnetic layer and the magnetic layer are sequentially laminated. New Claim 12 includes similar features but directed to a method for making a magnetic recording medium.

Applicants respectfully submit that Katsumi does not teach or suggest each feature of the independent claims. In particular, Applicants submit that Katsumi does not teach or suggest that the magnetic layer is configured to store information to be reproduced by a magneto-resistive (MR) head. Katsumi is silent regarding the configuration of the magnetic

layer for storing information to be reproduced by a MR head nor any reason to “optimize” for any particular magnetic head system as urged at page 3 of the outstanding Office Action.

Before optimization can be said to be “obvious” the prior art must present some recognition that the variable to be optimized is a result effective one. See In re Antonie 195 USPQ 6 (CCPA 1977). Accordingly, Applicants respectfully submit that Katsumi does not teach or suggest “a magnetic layer . . . configured to store information to be reproduced by a magneto-resistive (MR) head,” as recited in amended Claim 1, and as similarly recited in new Claim 12.

Further, Applicants specification clearly indicates an average height of protrusion of the abrasive from a surface of the magnetic layer is in the critical range of 7.0 to 15.0 nm, especially as shown by the comparative examples.¹ Alternatively, Katsumi shows a range of 15.0 nm or less, and does not indicate any lower limit to the range.² Thus, Applicants respectfully submit that Katsumi does not teach or suggest that an average height of protrusion of the abrasive from a surface of the magnetic layer is in the critical range of 7.0 to 15.0 nm.

In addition, Applicants respectfully submit that Katsumi does not teach or suggest each of the features in new dependent Claims 13-20.

Accordingly, Applicants respectfully submit that independent Claims 1 and 12, and claims depending therefrom, are allowable over Katsumi.

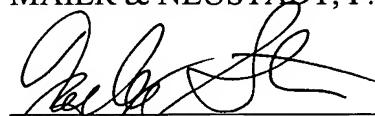
¹ Specification at page 6, lines 4-7, page 20, line 13, to page 34, line 8, and Table 1 at page 35.

² Katsumi at paragraph [0007].

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Mayer
Attorney of Record
Registration No. 25,599

Zachary S. Stern
Registration No. 54,719

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

GJM:ZSS:dnf